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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,916	07/11/2003	Yutaka Tosaki	Q76524	2409

23373 7590 08/11/2006

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EXAMINER	
EGWIM, KELECHI CHIDI	
ART UNIT	**PAPER NUMBER**
1713	

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/616,916	TOSAKI ET AL.	
	Examiner	Art Unit	
	Dr. Kelechi C. Egwim	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 July 2006*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) *2 and 4-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *050906*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/26/2006 has been entered.

Claim Rejections - 35 USC § 102/103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Iijima et al. or Rosenski et al., for reasons cited in the previous action.

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Kunihiro et al. (JP 2001172579).

In the abstract, Kunihiro et al. teach an aqueous dispersion type pressure-sensitive adhesive composition comprising a polyalkylene glycol having up to 500 degrees or polymerization (well within the claimed molecular weight range), in an amount of from 1 to 30 parts by weight per 100 pats by weight, on a solid basis, of the acrylic pressure-sensitive adhesive composition of the aqueous type dispersion.

While Kunihiro et al., may not expressly teach the product to be prepared by the exact same process recited in the claims, the product is the same as, or an obvious variant of, the presently claimed product absent evidence that the particular process of making results in a materially different product. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even thought the prior product was made by a different process. See In re Marosi, 218 USPQ 289 (Fed. Cir. 1983) and In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

Response to Arguments

6. Applicant's arguments and declaration filed 07/26/2006 have been fully considered but they are not persuasive.

7. Regarding the declaration, with regard to Iijima et al., the declaration is not sufficiently representative of the reference. Iijima et al. only requires about 3% of the low MW polyglycol to be present, yet the declaration only uses an example with 15% of the low MW poly glycol. This is insufficient to show that the small amount of the low MW compound required by Iijima et al. (3%) will adversely effect the adhesive, especially since it functions as an adhesive.

Also, the declaration is not commensurate in scope with the breath of the present claims, particular with regard to the adhesive type polymer(s) within the claims.

8. Regarding Rosenski et al., applicant stated that they did not obtain some of the reagents used in the reference, yet wants to use the substitute composition as proof to the Office of deficiently in the prior art. Applicant's representative experiment of Rosenski et al. did not result in an adhesive, yet we know through the disclosure of Rosenski et al. that the product in the reference DOES have cohesion and adhesion and function as a PSA. This is only further evidence that applicant has not properly and sufficiently reproduced or represented the invention of the prior art in the Declaration.

It remains true that, whether the polyglycol is added before or after polymerization, the product is the same as, or an obvious variant of, the presently claimed product absent evidence that the particular process of making results in a materially different product. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even thought the prior product was made by a different process. See In re Marosi, 218 USPQ 289 (Fed. Cir. 1983) and In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCE

KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER